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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,569	02/27/2006	Johathan Cox	0321.68322	7601
24978 7590 05/17/2010 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER				
BLAIR, DOUGLAS B				
ART UNIT		PAPER NUMBER		
2442				
MAIL DATE		DELIVERY MODE		
05/17/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/569,569

Applicant(s)

COX ET AL.

Examiner

DOUGLAS B. BLAIR

Art Unit

2442

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI/22)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/2010 has been entered.

Response to Amendment

The applicant has amended claims 1-4, 8, and 10-12. The applicant has indicated that claim 3 is amended but the Examiner cannot detect any amendment to claim 3. Claims 1-4 and 6-12 are currently pending.

Response to Arguments

The applicant's arguments against the 35 USC section 101 rejection of claim 11 are not persuasive because the amended claims are still broad enough to cover non-statutory subject matter. Specifically, claimed charging can still be performed by a person in an accounting capacity and the claimed permitting could be performed by the same person as claimed.

As to the prior art rejection, the Examiner agrees that there are differences between the applicant's disclosure and the Doshi invention however these differences are not adequately claimed. Doshi teaches "local phone service" in the extremely broad context of the applicant's claims as illustrated in the revised rejections below. While the examiner will agree that Doshi does not teach some of the subject matter on page 2 of the applicant's specification, the applicant

has not claimed the subject matter that the applicant is arguing patentably distinguishes from Doshi.

Even if the applicant were to properly claim a concept picking a host based on the geographic location of the host such a concept would not be novel because U.S. Patent Number 7,123,608 to Scott (see col. 2, lines 27-39) would make such a feature obvious in view of Doshi. No rejection is written at this time with Scott because the claims are so broad that they do not require it.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The claimed method including step of charging is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent. For example, charging could be completed by any person demanding money in an accounting capacity without the use of a machine.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 6,144,667 to Doshi et al.

As to claim 1, Doshi teaches a method for providing telephony services through the Internet, the method comprising steps of: by a server available through the Internet (**col. 6, lines 20-25, the voice/data network gateway 120 is a server accessible via the Internet**), communicating with a plurality of hosts, each host being connected to a local phone service via a local phone line to the server via the Internet (**Figure 1A, the voice switches are the hosts**), the server communicating with clients through the Internet to provide clients access to local phone services and communications through the local phone lines of the plurality of hosts (**col. 6, lines 43-50**).

As to claim 2, the voice/data network gateway 120 reads on the claimed server for the same reason indicated in the rejection of claim 1.

As to claim 3, Doshi teaches the server of claim 2, wherein the server computer is configured to provide one or more of the following services: authentication, tunneling, initiation of peer-to-peer communication, routing, directory, directory search, and access rights (Summary of Invention).

As to claim 4, the voice switches read on the claimed hosts for the same reason indicated in the rejection of claim 1.

As to claim 6, Doshi teaches the host of claim 4, wherein the server controls client access to the host (col. 6, lines 12-53).

As to claim 7, Doshi teaches the host of claim 6, wherein the server is configured to provide one or more of the following services: directory search, voicemail and missed calls, call answering, and call initiation (call answering).

As to claim 8, it is rejected for the same reasoning as claim 1.

As to claim 9, Doshi teaches the client of claim 8, wherein the client device is configured to provide one or more of the following services: phone line interface, authentication, verification, call forwarding, call answering, voice mail and missed calls, and local-call routing (call answering).

As to claim 10, it is rejected for the same reasoning as claim 1.

As to claim 11, it is rejected for the same reasoning as claim 1. The third paragraph of the summary discusses charging in the broad context claimed by the applicant.

As to claim 12, it is rejected as indicated in the preceding rejections.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art

of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DOUGLAS B. BLAIR** whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Lee can be reached on (571) 272-3967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/
Primary Examiner, Art Unit 2442